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**REMARKS**

Entry of this Amendment is proper since it narrows the issues on appeal and does not require further searching by the Examiner.

Claims 1-50 are all the claims presently pending in the application. Claims 1, 21, 40, 44 and 46-47 have been amended to more particularly define the claimed invention.

It is noted that the claim amendments are made only to assure grammatical and idiomatic English and improved form under United States practice, and are not made to distinguish the invention over the prior art or narrow the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 2, 4-7, 9-17, 20-37 and 40-49 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Yamauchi et al. (U.S. Patent No. 6,020,982). Claims 3, 8, 18, 19, 38, 39 and 50 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamauchi in view of Litwin (U.S. Patent No. 6,374,228).

These rejections are respectfully traversed in the following discussion.

**I. THE CLAIMED INVENTION**

The claimed invention (e.g., as recited, for example, in claim 1) is directed to an image data output apparatus for outputting to a second medium, image data recorded in the first medium received from a customer. The apparatus includes a reader for reading out the image data recorded in the first medium, an output unit for outputting the image data to the second medium which is a different type of medium than the first medium (Application at page 12, lines 25-31), a digital contents storage unit for storing digital contents to be stored in the first medium, a selector for selecting from a plurality of the digital contents stored in the digital contents storage unit the digital contents to be provided to the customer based on a predetermined selection condition, and a recorder for recording the selected digital contents in the first medium.

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Conventionally, when a photoshop performs a media conversion for a customer (e.g., has data on a first medium (e.g., memory card) recorded on a second medium (e.g., paper or CD-R)), the first medium is returned to the customer in the same condition as when the customer arrived at the photoshop (Application at page 1, line 32-page 2, line 5). The customer may then be handed a publicity handout (e.g., a paper including advertising or sales information) by the clerk working at the photoshop.

The claimed invention, on the other hand, includes an output unit for outputting the image data to the second medium which is a different type of medium than the first medium (Application at page 12, lines 25-31). Thus, for example, in an exemplary aspect of the claimed invention, after the data on a memory card is recorded on a different type of medium (e.g., paper), the memory card may be returned to the customer with selected digital contents (e.g., advertising and/or sales information) recorded thereon, which may eliminate the need for the clerk to hand such information (e.g., paper advertisement or sales information) to the customer.

## II. THE ALLEGED PRIOR ART REFERENCES

### A. Yamauchi

The Examiner alleges that the invention of claims 1, 2, 4-7, 9-17, 20-37 and 40-49 are anticipated by Yamauchi. However, Applicant respectfully submits that Yamauchi does not teach or suggest each and every element of the claimed invention.

Yamauchi discloses an electronic still camera which may record an image onto a memory card (Yamauchi at Abstract).

However, Yamauchi does not teach or suggest "*an output unit for outputting the image data to the second medium which is a different type of medium than said first medium*", as recited in claim 1 and similarly recited in claims 21, 23 and 40.

As noted above, in an exemplary aspect of the claimed invention, after the data on a memory card is recorded on a different type of medium (e.g., paper), the memory card may be

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returned to a customer with selected digital contents (e.g., advertising and/or sales information) recorded thereon, which may eliminate the need for the clerk to hand such information (e.g., paper advertisement or sales information) to the customer.

Clearly, these features are not taught or suggested by Yamauchi.

Indeed, Applicant would point out that in the claimed invention, a first medium (e.g., which is received from a customer) is a different type of medium than a second medium.

Specifically, a first medium may include a memory card or the like, while a second medium may include a disk, tape and so on. Yamauchi, on the other hand, clearly fails to teach or suggest this important feature of the claimed invention.

Further, Applicant would point out that on page 2 of the Office Action, the Examiner misrepresents Applicant's argument in the Amendment filed on September 30, 2005.

Specifically, nowhere in that Amendment did Applicant assert that the cited references do not teach or suggest "recording data onto a memory card". Instead, Applicant asserted that nowhere do the cited references teach or suggest "*a recorder for recording said selected digital contents in the first medium*".

That is, Applicant is not asserting that in the claimed invention the first medium is limited to a memory card. Instead, Applicant is asserting that **in an exemplary aspect of the claimed invention**, the first medium may include a memory card.

Further, Applicant would point out that Yamauchi is completely different from the claimed invention. Indeed, Yamauchi merely discloses a camera 11 that records digital image data in the memory card 400, and the digital image data may be delivered from the memory card 400 to the disc and tape recorders 802, 803 via the editing machine 600 (Yamauchi at col. 9, lines 1-22). **This has little to do with the claimed invention.**

Indeed, the Examiner surprisingly attempts to equate the memory card 400 in Yamauchi with the first medium in the claimed invention. However, the Examiner ignores that in an exemplary aspect of the claimed invention (e.g., as defined, for example, by claim 1), the first medium may be "*received from a customer*". Nowhere does Yamauchi teach or suggest that the

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memory card 400 is received from a customer.

Indeed, Applicant would point out that the term "customer" as recited, for example, in claim 1, may be defined as "a person or business that purchases a commodity or service" (e.g., see [www.dictionary.com](http://www.dictionary.com)). The Examiner cannot simply ignore this term on a whim but instead he must consider this term in construing the claims. However, nowhere does the Examiner even attempt to show that Yamauchi teaches or suggests that the memory card 400 is "received from a customer".

Incidentally, Applicant also would point out that the exemplary aspect of the claimed invention defined by claim 1 includes "*a selector for selecting from a plurality of said digital contents stored in said digital contents storage unit said digital contents to be provided to the customer based on a predetermined selection condition*". That is, this exemplary aspect of the claimed invention may include a selector for selecting digital contents to be provided to the customer (e.g., the customer from whom the first medium may be received). Nowhere does Yamauchi teach or suggest this feature.

Therefore, nowhere does Yamauchi teach or suggest an output unit for outputting the image data to the second medium which is a different type of medium than the first medium (e.g., the first medium received from a customer).

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggest by Yamauchi. Therefore, the Examiner is respectfully requested to withdraw this rejection.

#### B. Litwin

The Examiner alleges that Yamauchi would have been combined with Litwin to form the invention of claims 3, 8, 18, 19, 38, 39 and 50. However, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Litwin discloses a rebate advertising system in which an individual who affixes

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advertisements such as bumperstickers to his car can be provided a rebate (Litwin at Abstract).

Applicant respectfully submits that these references would not have been combined as alleged by the Examiner. Indeed, these references are completely clearly unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, contrary to the Examiner's allegations, neither of these references teaches or suggests their combination.

Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Yamauchi, nor Litwin, nor any combination thereof teaches or suggests "*an output unit for outputting the image data to the second medium which is a different type of medium than said first medium*", as recited in claim 1 and similarly recited in claims 21, 23 and 40.

Clearly, these features are not taught or suggested by Litwin.

Indeed, Applicant would point out that Litwin merely discloses that an advertisement is noted to be placed onto various media. However, even a person skilled in the art could not likely discover that the "system for providing advertisement" (e.g., including a digital data) of Litwin may be used in "an image data output apparatus" as defined, for example, in claim 1. Thus, it is completely unreasonable for the Examiner to attempt to suggest that Litwin would have been combined with Yamauchi to form the invention of claims 3, 8, 18, 19, 38, 39 and 50.

In short, as noted above, Litwin deals only with a rebate advertising system in which an individual who affixes advertisements such as bumperstickers to his car can be provided a rebate (Litwin at Abstract). Nowhere does Litwin even teach or suggest an image data output apparatus for outputting image data (e.g., recorded in first medium **received from a customer**) to a second medium.

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Certainly, nowhere does Litwin teach or suggest an output unit for outputting the image data to the second medium which is a different type of medium than the first medium. Therefore, Litwin clearly does not make up for the deficiencies of Yamauchi.

Therefore, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

### III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-50, all the claims presently pending in the application, are patentably distinct over the prior art of record and are allowable, and that the application is in condition for allowance. Such action would be appreciated.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below to discuss any other changes deemed necessary for allowance in a telephonic or personal interview.

The Commissioner is authorized to charge any deficiency in fees, including extension of time fees, or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,



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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing was filed by facsimile with the United States Patent and Trademark Office, Examiner Jamie Vent, Group Art Unit # 2616 at fax number (571) 273-8300 this 28<sup>th</sup> day of March, 2006.



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